

Remarks/Arguments:

The pending claims are 1-16. Claims 1 and 3 have been amended. Claims 13-16 have been added. No new matter has been introduced therein.

The disclosure has been objected to because page 6 of the specification does not state that Figure 28 represents prior art. Since the specification has been amended, applicants request that this objection be withdrawn.

Claim 3 has been objected to because of a lack of antecedent basis. Since claim 3 has been amended, applicants request that this objection be withdrawn.

Claims 1, 7 and 8 have been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art drawings and background of the invention in view of Toda et al. (U.S. Patent No. 5,712,540), Baader et al. (U.S. Patent No. 5,237,494) and Ciaccio (U.S. Patent No. 5,594,199). Applicants respectfully disagree but have amended claim 1 so that it recites that the radiator is disposed in the case, in addition to the drive-motor driving device, the compressor-driving device, and the smoothing capacitor. The amendment is supported by page 7, lines 1-3 of the specification. Including the radiator inside the case, along with the other components, enables the electric vehicle to be downsized and to make it more light-weight. (page 3, lines 19-22).

Page 4 of the Office Action contends that it would have been obvious to modify the device disclosed by applicants' prior art in various ways as purportedly taught by Toda, Baader, and Ciaccio. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. MPEP § 706.02(j).

Here, the Office Action relied upon hindsight to arrive at the determination of obviousness. There is no suggestion in the prior art references to make the claimed combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Federal Circuit has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ 2d 1780, 1783, 1784 (Fed. Cir. 1992).

In addition, applicants have now amended claim 1 so that it recites that the radiator is also enclosed within the case. This feature is not shown or suggested by the prior art. As noted above, inclusion of the radiator within the case provides definite advantages. Accordingly, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over applicants' prior art in view of Toda, Baader, and Ciaccio.

Since claims 7 and 8 depend from amended claim 1, they are also not subject to rejection under 35 U.S.C. § 103(a) for at least the same reasons that amended claim 1 is not subject to rejection.

Claims 2, 10 and 11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, and Ciaccio "as applied to claims 1, 4, and 5 above," and further in view of Betsusou et al. (JP 64-031380). This rejection is confusing because claims 4 and 5 were not rejected in paragraph 3 "above." Instead, claims 4 and 5 have been rejected later in the Office Action at paragraphs 6 and 7. Therefore, the rejection of claims 4, 5, 10, and 11 will be covered at later points in the present response.

Claim 2 depends from amended claim 1. Including applicants' disclosed prior art, amended claim 1 has been rejected based on four prior art references. The Office Action has now rejected claim 2 based upon a total of five references, the fifth reference being Betsusou. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 2. For those reasons alone, claim 2 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Betsusou does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Betsusou alone or as unpatentable over Betsusou in combination with all of the other references that were used to reject claim 1. Since claim 2 depends from amended claim 1, claim 2 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio, and further in view of Makaran (U.S. Patent No. 5,744,921). Claim 3 depends from amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 3. For those reasons alone, claim 3 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Makaran does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Makaran alone or as unpatentable over Makaran in combination with all of the other references that were used to reject claim 1. Since claim 3 depends from amended claim 1, claim 3 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claim 4 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio and further in view of Wagner (U.S. Patent No. 6,207,900). Claim 4 depends from amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 4. For those reasons alone, claim 4 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Wagner does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Wagner alone or as unpatentable over Wagner in combination with all of the other references that were used to reject claim 1. Since claim 4 depends from amended claim

1, claim 4 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio and further in view of Tsukamoto et al. (U.S. Patent No. 6,476,329). Claim 5 depends from amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 5. For those reasons alone, claim 5 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Tsukamoto does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Tsukamoto alone or as unpatentable over Tsukamoto in combination with all of the other references that were used to reject claim 1. Since claim 5 depends from amended claim 1, claim 5 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claim 6 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, and Ciaccio and further in view of Pieronek et al. (U.S. Patent No. 5,452,201). Claim 6 depends from amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 6. For those reasons alone, claim 6 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Pieronek does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Pieronek alone or as unpatentable over Pieronek in combination with all of the other references that were used to reject claim 1. Since claim 6 depends from amended claim 1, claim 6 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claim 9 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio and further in view of Watson (U.S. Patent No. 6,414,455). Claim 9 depends from amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claim 5. For those reasons alone, claim 5 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Watson does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Watson alone or as unpatentable over Watson in combination with all of the other references that were used to reject claim 1. Since claim 9 depends from amended claim 1, claim 9 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

In paragraph 4 of the Office Action, claims 10 and 11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio "as applied to claims 1, 4, and 5 above," and further in view of Betsusou. The Office Action did not reject claims 4 and 5 in any paragraphs prior to paragraph 4. Only claims 1, 7, and 8 were rejected in paragraph 3 of the Office Action. Claim 10 depends from claims 4 and 1. Claim 11 depends from claims 5 and 1. As noted above, claim 1 has been rejected based on four references; claim 4 has been rejected based on the same four references plus Wagner; claim 5 has been rejected based on the same four references plus Tsukamoto.

Since claim 10 depends from claims 4 and 1, applicants assume that the Office Action intended to reject claim 10 based upon a combination of all the references cited against claims 10, 4, and 1: applicants' disclosed prior art, Toda, Baader, Ciaccio, Betsusou, and Wagner, a total of six references. Since claim 11 depends from claims 5 and 1, applicants assume that the Office Action intended to reject claim 11 based upon a combination of all the references cited against claims 11, 5, and 1: applicants' disclosed prior art, Toda, Baader, Ciaccio, Betsusou, and Tsukamoto, a total of six references.

Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of claim 1 and apply them to the rejection of claims 10 and 11. For

those reasons alone, claims 10 and 11 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited six prior art references.

In addition, since none of the six cited prior art references shows or suggests all of the features recited in amended claim 1, claim 4, or claim 5, none of those claims is subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the combination of the references. Since claim 10 depends from amended claim 1 and claim 4; and since claim 11 depends from similarly amended claim 1 and claim 5, claims 10 and 11 are also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the respectively cited six prior art references.

Claim 12 has been rejected under 35 U.S.C. § 103(a) as unpatentable over applicants' disclosed prior art, Toda, Baader, Ciaccio and further in view of Goto et al. (U.S. Patent No. 5,714,806). Claim 12 depends from claim 8 and amended claim 1 and has been rejected based upon five references. Applicants incorporate by reference the "hindsight reconstruction" arguments they made regarding the rejection of amended claim 1 and apply them to the rejection of claim 12. For those reasons alone, claim 12 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited five prior art references.

In addition, since Goto does not show or suggest all of the features recited in amended claim 1, amended claim 1 is not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Goto alone or as unpatentable over Goto in combination with all of the other references that were used to reject claim 1. Since claim 12 depends from claim 8 and amended claim 1, claim 12 is also not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

Claims 13-16 have been added. Each of these claims is based upon claim 1 as originally filed. Claim 13 is a combination of original claims 1, 3 and 4. Claim 14 is a combination of original claims 1, 3, and 5. Claim 15 is a combination of original claims 1, 3, and 6. Claim 16 is a combination of original claims 1 and 8.

The rejection of originally filed claim 1 (and the anticipated rejection of newly added claims 13-16) is respectfully traversed.

Applicants restate and incorporate by reference the "hindsight reconstruction" arguments they made earlier in this response regarding the rejection of claim 1. In addition, applicants point out that there is no suggestion in any of the references to produce an electric vehicle having an electric circuit with all of the combined features respectively recited in each of claims 13-16.

The Office Action contends that Toda discloses a capacitor that is coupled to the inputs of two different motor driving devices. In other words, the Office Action contends that paragraph (f) in these claims is disclosed in Figure 1 because element 2e is coupled to elements 4 and 13. Applicants respectfully disagree. Elements 4 and 13 are inverter circuits. (col. 6, lines 22-23). They are not driving circuits. Smoothing capacitor 2e (col. 2, line 15) is coupled to the inverter circuits. (col. 7, lines 64-66). Although Toda does have driving circuits 26, 27, smoothing capacitor 2e is not coupled to an input terminal of either of the driving circuits 26, 27. Instead, the input of the driving circuits is coupled to microcomputer 25. (col. 6, lines 20-24).

In addition, each of these claims recites, in part, a smoothing capacitor that is disposed in a case that shields electromagnetic waves. Page 4 of the Office Action contends that "it would have been obvious. . .to modify the circuit disclosed by the Applicant as Prior Art with. . .a case that encloses. . .the smoothing capacitor, thereby providing the advantage of reducing improper circuit operation due to interference as taught by Ciaccio." Applicants respectfully disagree. Although Ciaccio does disclose a cover 62 having a "baffle for the reduction of EMI [electromagnetic interference] into and out of the package of the ECM [electronic control module] 12," (col. 1, lines 6-7; col. 4, lines 18-19; col. 6, lines 22-23), Ciaccio does not disclose or suggest that a smoothing capacitor could be placed inside the cover. In fact, Ciaccio does not even mention the presence of a capacitor. Since there is no suggestion in any of the references that a smoothing capacitor could be placed inside a cover in the context of device as recited in claims 13-16, claims 13-16 cannot be rejected over the cited prior art because the cited prior art fails to show all of the elements recited in them. That is, the references, even when combined, do not teach or suggest all the claim limitations.

For all of the reasons stated above, claims 13-16 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over the cited prior art.

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Reply to Office Action of: June 10, 2003

MAT-8191US

The prior art of record and not relied upon is not considered any more pertinent to applicants' disclosure than that already cited.

For the all of the foregoing reasons, applicants respectfully solicit allowance of the entire application.

Respectfully submitted,



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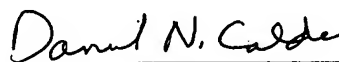
Dated: August 26, 2003

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